

REMARKS

Applicant has carefully studied the Office Action of September 21, 2005, and offers the following remarks in response thereto.

Before addressing the current rejections, Applicant provides a brief summary of the present invention so that the remarks are considered in the proper context. The present invention is designed to allow a single mobile terminal to move between a cordless mode and a cellular mode. In the cordless mode, the mobile terminal uses a terminal adaptor which, as defined in paragraph 0004, is capable of communicating wirelessly with the mobile terminal. In this manner, a customer may have a single mobile terminal yet operate in both a wireline mode and a wireless mode. Operation in the wireline mode does not require the mobile terminal to be connected to the wireline network via a wire since the mobile terminal communicates with the terminal adaptor wirelessly. The mobile terminal has a single phone number, and regardless of where the mobile terminal is located, calls directed to the single phone number are routed to the mobile terminal through the appropriate network. In the preferred embodiment, the calls are directed to the wireline system first, so as to avoid charges associated with use of the cellular network. Only if the mobile terminal is not available on the wireline network is the call routed to the wireless network.

Applicant adds new claim 37 that highlights the wireless connection between the terminal adaptor and the mobile terminal. Support for this new claim can be found in at least paragraph 0004. No new matter is added.

Claims 1-4, 6-15, and 19-32 were rejected under 35 U.S.C. §102(b) as being anticipated by Malmstrom. Applicant respectfully traverses. For the Patent Office to prove anticipation, the Patent Office must show where each and every element of the claim is located in the reference. Further, the elements of the reference must be arranged as claimed. MPEP § 2131. Anticipation is a strict standard that has not been met in the present application.

Claim 1 recites "determining whether to route an incoming call intended for a directory number supported by a wireline switch to a mobile terminal via a terminal adaptor operatively associated with the wireline switch or to the mobile terminal via a cellular network. . . ." The Patent Office asserts this element is shown at Malmstrom, col. 10, lines 14-38. Applicant traverses this assertion. Malmstrom, col. 10, lines 14-38 states in full:

Mapping provides the single-number service subscriber with the capability to map a wireline DN call to a wireless mobile unit 40/MIN for purposes of call delivery to the subscriber who is currently located within wireless network 30. Again, note that the MIN may be treated as an unpublished number in the single-number service because a calling party will only dial the DN associated with the subscriber and not the MIN. Furthermore note that the reverse mapping (MIN to DN) is required in order to relate wireless usage to a common wireline DN telephone bill.

Wireless/Wireline call routing represents an internetworking function responsible for delivering single-number DN calls to the appropriate wireless 30 or wireline 12 network based upon current subscriber location information. The wireless/wireline call routing decision is made based upon location status information maintained within WLR 24, previously described. Note that since MIN's are expected to be an unpublished number, the wireless network 30 is not expected to perform call termination based upon MIN's. In fact, the wireless network can be prohibited from performing MIN call terminations to ensure that wireline network 12 maintains call termination control. The wireless/wireline call routing function is performed by AIN/SCP service logic using registration status information stored within WLR 24.

There is no terminal adaptor operatively associated with the wireline switch within this passage. While the passage discusses the single-number DN being mapped to the unpublished MIN, there is nothing that correlates to a terminal adaptor. If the Patent Office disagrees, Applicant requests that the Patent Office identify with particularity (and preferably by element number) what element within the passage is being construed to be the terminal adaptor.

Applicant notes that element b also recites a terminal adaptor. The Patent Office states the incoming call should be routed via the wireline location register (WLR) terminal adaptor and cites Malmstrom col. 10, lines 14-67. (Office Action of September 21, 2005, page 2, lines 18-20). It is unclear if the Patent Office is asserting that the WLR of Malmstrom is the terminal adaptor of the claim. If this is the Patent Office's assertion, Applicant traverses the assertion because the WLR is not consistent with the usage of terminal adaptor presented in the specification. While the Patent Office is entitled to give claim elements a broad interpretation, the Patent Office must not give the claim element an interpretation that is inconsistent with the specification. MPEP § 2111. No one of ordinary skill in the art would consider the WLR to be a terminal adaptor as that term is used in the specification. Applicant has likewise studied the extended citation to Malmstrom and sees no element therein that can be construed to be a terminal adaptor. If the Patent Office disagrees, Applicant requests that the Patent Office

identify with particularity (and preferably by element number) what element within the passage is being construed to be the terminal adaptor.

The Patent Office also indicates that the rest of element b and element c are taught by Malmstrom, col. 10, line 14-col. 11, line 28. Applicant has studied this passage and sees nothing therein that can be construed to be a terminal adaptor. While the passages recite the SSP 16, the SCP 22, and the MSC 32, these are not, under any reasonable interpretation, a terminal adaptor as that term is used in the specification.

In short, Malmstrom does not teach the terminal adaptor of claim 1. Since Malmstrom does not teach this element, Malmstrom does not anticipate claim 1. Claims 2-4 and 6-15 depend from claim 1 and are not anticipated for at least the same reasons. Applicant requests withdrawal of the § 102 rejection of claims 1-4 and 6-15 at this time.

Claim 19 is essentially identical to claim 1. As explained above, Malmstrom does not teach or suggest the terminal adaptor. Claims 20-32 depend from claim 19 and are not anticipated for at least the same reasons. Applicant requests withdrawal of the § 102 rejection of claims 19-32 at this time.

New claim 37 recites that the mobile terminal receives communications from the terminal adaptor wirelessly. Even if there is some element within the passage that can be construed to be a terminal adaptor, there is no teaching or suggestion that it communicates with the wireless terminal wirelessly while being operatively associated with the wireline switch. The mobile terminals of Malmstrom never communicate directly with the wireline network and never interoperate with a terminal adaptor to interoperate with the wireline network. Thus, new claim 37 is not anticipated and is allowable.

Claims 5 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Malmstrom in view of Easley et al. (hereinafter "Easley"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Once the combination is properly made, for the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element can be found in the combination of references. MPEP § 2143.03.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation combine the references. Specifically, the Patent Office asserts that the motivation is "for the serving MSC to inform the home location register temporary routing information on how the incoming call should be routed to the mobile station within the wireless network. . ." (Office Action of September 21, 2005, page 5, lines 24-27). This asserted motivation lacks the required evidence. Since the motivation lacks the required evidence, the motivation to combine the references is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the Patent Office has not established obviousness, and the claims are allowable. Applicant requests withdrawal of the § 103 rejection of claims 5 and 33 on this basis.

Even if the combination is proper, a point which Applicant does not concede, the combination does not establish obviousness. As explained above, Malmstrom does not teach the terminal adaptor of the independent claims 1 and 19. The Patent Office has not pointed to anything within Easley that cures the deficiency of Malmstrom. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness. Since the combination does not establish obviousness, the claims are allowable. Applicant requests the withdrawal of the § 103 rejection of claims 5 and 33 on this basis, as well.

Claims 16-18 and 34-36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Malmstrom in view of Hallensal. Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation combine the references. Specifically, the Patent Office asserts that the motivation is "to change the customer premises equipment (CPE) to a cordless phone so that a user can roam through a house while communicating with the wireline network. . ." (Office Action of September 21, 2005, page 6, lines 3-6). This asserted motivation lacks the required evidence. Since the motivation lacks the required evidence, the motivation to combine the references is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the

Patent Office has not established obviousness, and the claims are allowable. Applicant requests withdrawal of the § 103 rejection of claims 16, 17, 34, and 35 on this basis.

Applicant traverses the second motivation of the rejection because the Patent Office has not properly supported that motivation to combine the references, either. Specifically, the Patent Office asserts that the motivation is "for the wireless network to operate at a particular frequency band for its mobile subscribers. . ." (Office Action of September 21, 2005, page 6, lines 14-15). This asserted motivation lacks the required evidence. Since the motivation lacks the required evidence, the motivation to combine the references is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the Patent Office has not established obviousness, and the claims are allowable. Applicant requests withdrawal of the § 103 rejection of claims 18 and 36 on this basis.

Applicant requests reconsideration of the rejections in light of the remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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